

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of
WIRTH et al
Serial No. 09/922,938
Filed: August 7, 2001
For: LATHE APPARATUS



Atty. Ref.: 3584-9
Group: 3722
Examiner: Walsh

May 5, 2004

Assistant Commissioner for Patents
Washington, DC 20231

REPLY BRIEF

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Sir:

Applicant submits herewith their Reply Brief in triplicate pursuant to 37 CFR §1.193(b)(1). A Request for Oral Hearing is being concurrently filed.

The Examiner's Answer states on page 2 that the Brief does not contain a statement identifying the related appeals and interferences. This is incorrect as the required statement is included on page 1 of the Appeal Brief as Section 2.

In Section (11)A of the Examiner's Answer, the Examiner argues for the first time that there is an unlabeled feature in Figure 1 of McCormack, which the Examiner labels as "X" and which the Examiner deems to be "a second base unit", although the Examiner admits that this element is no where described in McCormack.

Applicant respectfully challenges the Examiner's "new" interpretation of McCormack and conclusions therefrom. Firstly, while the Examiner has said that "one of ordinary skill in the art would clearly determine" that the unlabeled and not described element is a second base unit, the Examiner has cited no basis or evidence as to why

one of ordinary skill would allegedly reach this conclusion. Indeed, it is respectfully submitted that without the benefit of applicant's disclosure, the skilled artisan would never make such a conclusion from McCormack because the unlabeled element in McCormack, as illustrated, is no more than a plate that is evidently secured to the bed extension 14. The Examiner's suggestion that the "lower surface of the bed even includes a step-portion above supposed base unit (X) to meet this feature" is unjustified because such a "step-portion" is actually provided at each longitudinal end of bed 14 and even though fasteners are apparently shown at the end of bed 14 close to the motor unit, there is no structure shown attached to that step either. Even further, it is evident from the perspective view of Figure 2 of McCormack, which shows bed 14 and bed 14A, that McCormack does not include any second base unit. Indeed, if anything McCormack teaches away from the provision of a second base unit as claimed because he clearly provides only a cantilever structure.

In Section (11)B, at page 8, the Examiner isolates a remark regarding the ergonomic and aesthetically pleasing assembly of the tailstock claimed and embeds 3 illustrations of allegedly ergonomic tailstocks. It is noted that two of the three patents identified by the Examiner are not of record and the third has not been applied in any rejection against the claims. It is therefore not possible to determine what prior art combination the Examiner is envisioning. Further, it cannot be determined what argument in the Brief the Examiner intends to rebut because his comments regarding the ergonomic tailstock feature are included in Section B, regarding claim 15, which does not include and was not argued as including the ergonomic tailstock feature. To the extent the Examiner intended to refer to the Section C of the Brief, it is respectfully submitted that it is only appropriate for the Examiner to consider the combination claimed not, isolated features of applicant's claims. In respect to the prior art as combined by the Examiner, it is submitted that the Examiner has not established a *prima facie* case of obviousness with respect to the combination claimed.

In Section C of the Examiner's Answer, the Examiner questions appellant's argument that Hardy predates McCormack by over 35 years. In this regard, appellant was not commenting on the age of the reference *per se* but rather the relative age of the two references combined by the Examiner. Because the primary reference to McCormack relates to an invention developed over 35 years after Hardy, presumably McCormack was aware of Hardy as well as the other prior art thereto and yet does not adopt any of the features of Hardy identified by the Examiner. Applicant respectfully submits that this underscores that it would not have been obvious to the skilled artisan to reconfigure McCormack in view of Hardy as suggested by the Examiner.

The Examiner further argues, on page 9, that Hardy's disclosure is allegedly incomplete because "it is conceivable that in order to please the Office and facilitate prosecution, Hardy [limited his disclosure]". The Examiner's argument is, frankly, absurd. There is no evidence whatsoever that Hardy provided an incomplete disclosure and/or did not disclose his "best mode" and the Examiner's suggestion that Hardy limited his disclosure to "simplify prosecution" and "please the Office" is without any basis whatsoever. It remains quite clearly the case that the Examiner has selected isolated features of several references and undertaken a piecemeal reconstruction of the invention, whereas one skilled in the art reviewing the prior art identified by the Examiner, and without benefit of applicant's disclosure, would not have "obviously" selected and combined the isolated components the Examiner has proposed. Fundamentally lacking in the Examiner's proposed combination is a motivation or basis for combining the teachings of the prior art so as to produce the claimed invention.

In Sections D and E of the Examiner's Answer, the Examiner argues that the "slider block" is viewed as a combination of elements 12 and 13 in Clay. It is respectfully submitted, however, that parts 13 and 12 cannot properly be considered a part of "block" because cam 13 is a part of the cam shaft and moves upward and

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downward in relation to the support block 12 so that cam 13 and block 12 cannot be considered parts of a (singular) support block. Thus, there is no anticipation of claim 20 or claim 21.

For all the reasons advanced in appellant's Brief on Appeal and further for the reasons advanced above, reversal of the Examiner's rejection and allowance of all claims is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

A handwritten signature in black ink, appearing to read "Michelle N. Lester", written over a horizontal line.

Michelle N. Lester

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